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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,678	03/29/2004	Steven Sachs	0012	2969

43699 7590 08/28/2008

GO DADDY GROUP, INC.
14455 NORTH HAYDEN ROAD
SUITE 219
SCOTTSDALE, AZ 85260

EXAMINER	
STRODER, CARRIE A	
ART UNIT	PAPER NUMBER
4154	
MAIL DATE	DELIVERY MODE
08/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/811,678	SACHS ET AL.	
	Examiner	Art Unit	
	CARRIE A. STRODER	4154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

a. Page 1: the cross references have only a blank for the patent application number;

b. Page 2, 4th paragraph: "severely" is misspelled;

c. Page 14, 3rd paragraph: "…a partnerships, a start-up businesses and an existing businesses looking…" should be corrected in order that the articles agree with the nouns they modify;

d. Page 14, 4th paragraph: "…used only business activities…" should read "…used only for business activities…"

e. Page 14, 5th paragraph: "…an associated Internet protocol addresses…" should be corrected in order that the article agree with the noun it modifies;

f. Page 16, 1st full paragraph: makes reference to drawings 3a-c, 4 & 5; however there are no drawings numbered 3a-c or 5;

g. Page 16, 2nd full paragraph: "accessible" is misspelled as "assessable";

h. Page 16, 3rd full paragraph: "desire" should be "desired";

i. Page 17, 2nd full paragraph: "…will increase the Entrepreneur 101 chance…" should be "…will increase the Entrepreneur's 101 chance…";

j. Page 21, 1st paragraph: "…the work made for hire…" should be "…the work was made for hire…"; and

k. Page 24, 1st full paragraph: "…Entrepreneurs only have to be enter information and single time…" should be "…Entrepreneurs only have to enter information a single time…"

Appropriate correction is required.

2. The use of multiple trademarks has been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed method is performed by a Facilitator (a businessman, a human being, or a business entity). The method as claimed is implemented by a human being and not by a machine. The subject matter claimed, therefore, pertains to a judicial exception of an abstract idea. In order for a judicial to be patent eligible i.e., possessing a practical application, it must be A)"transforms" an article or physical object to a different state or thing; or (B) otherwise produces a useful, concrete and tangible result. See MPEP 2106(IV)(B)(2). Claims 1-19 fail to satisfy neither, and thus, is not statutory.

Claim Rejections - 35 USC § 102

5. Claims 1-3, 7-9, and 13-15 are rejected under 35 U.S.C. 102(b) based upon a public use or on sale of the

invention. Assignee The Go Daddy Group, Inc. has sold the invention via its web site since at least 02 February 2003.

In *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 66-68, 119 S.Ct. 304, 311-12, 48 USPQ2d 1641, 1647 (1998), the Supreme Court enunciated a two-prong test for determining whether an invention was "on sale" within the meaning of 35 U.S.C. 102(b) even if it has not yet been reduced to practice. "[T]he on-sale bar applies when two conditions are satisfied before the critical date [more than one year before the effective filing date of the U.S. application]. First, the product must be the subject of a commercial offer for sale…. Second, the invention must be ready for patenting." *Id.* at 67, 119 S.Ct. at 311-12, 48 USPQ2d at 1646-47.

The public use bar under 35 U.S.C. 102(b) arises where the invention is in public use before the critical date and is ready for patenting. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, 424 F.3d 1374, 76 USPQ2d 1741 (Fed. Cir. 2005). As explained by the court,

> The proper test for the public use prong of the § 102 (b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Commercial exploitation is a clear indication of public use, but it likely requires more than, for example, a secret offer for sale. Thus, the test for the public use prong includes the consideration of evidence relevant to experimentation, as

> well as, *inter alia*, the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation…. That evidence is relevant to discern whether the use was a public use that could raise a bar to patentability, but it is distinct from evidence relevant to the ready for patenting component of *Pfaff* 's two-part test, another necessary requirement of a public use bar.

See MPEP 2133.03(a).

Go Daddy sold the invention on its website since at least 02 February 2003. The invention was accessible to the public and commercially exploited; therefore, the invention was in public use.

"Ready for patenting," the second prong of the *Pfaff* test, "may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 67, 199 S.Ct. at 311-12, 48 USPQ2d at 1647. See MPEP 2133.03(c).

The invention was reduced to practice, as it was on Go Daddy's website and being used by customers of Go Daddy.

Furthermore, choosing a domain name that describes a business is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that choice of a domain name based on its description of a business adds little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 4-6, 10-12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of copyright.gov (weblink).

Referring to claims 4, 10, and 16:

Claim 4 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 10 is dependent from claim 7; therefore the rejection of claim 7 is incorporated herein. Claim 16 is dependent from claim 13; therefore the rejection of claim 13 is incorporated herein.

Go Daddy fails to teach further comprising the step of linking the Entrepreneur with the official web site for the United States Copyright Office. The Copyright Office has provided a link to copyright materials since at least 05 February 2001. One of ordinary skill in the art would look to the prior art for suggestions on how to make improvements in assisting an entrepreneur in starting an internet business. Therefore, the combined teachings of Go Daddy and copyright.gov would render claims 4 and 10 obvious because a person of ordinary skill in the art would find sufficient motivation to combine the prior art references in a manner, with a reasonable expectation of success, to achieve the claimed invention.

Referring to claims 5 and 11:

Claim 5 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 11 is dependent on claim 7; therefore the rejection of claim 7 is incorporated herein.

Go Daddy fails to teach further includes the steps of receiving copyright information from the Entrepreneur, creating

hardcopy copyright forms containing the copyright information, transmitting the hardcopy copyright forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Copyright Office. Go Daddy does not expressly teach this. However, the United States Copyright Office has conducted the above steps on its website, www.copyright.gov since at least 05 February 2001. One of ordinary skill in the art would look to the prior art for suggestions on how to make improvements in assisting an entrepreneur in starting an internet business. Therefore, the combined teachings of Go Daddy and copyright.gov would render claims 5 and 11 obvious because a person of ordinary skill in the art would find sufficient motivation to combine the prior art references in a manner, with a reasonable expectation of success, to achieve the claimed invention.

Referring to claims 6 and 12:

Claim 6 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 12 is dependent on claim 7; therefore the rejection of claim 7 is incorporated herein.

Go Daddy fails to teach further includes the steps of receiving copyright information from the Entrepreneur, creating electronic copyright forms containing the copyright information, and electronically submitting the hardcopy copyright forms to

the United States Copyright Office. Go Daddy does not expressly teach this. However, the United States Copyright Office has conducted the above steps on its website, www.copyright.gov since at least 05 February 2001. One of ordinary skill in the art would look to the prior art for suggestions on how to make improvements in assisting an entrepreneur in starting an internet business. Therefore, the combined teachings of Go Daddy and copyright.gov would render claims 5 and 11 obvious because a person of ordinary skill in the art would find sufficient motivation to combine the prior art references in a manner, with a reasonable expectation of success, to achieve the claimed invention.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All prior art revealed in the Information Disclosure Statement filed by applicant is hereby made of record.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 7:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 4154

/Vu Le/
Supervisory Patent Examiner, Art Unit 4154